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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/587,436

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Alain Moussy

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03/30/2011

FOLEY AND LARDNER LLP

SUITE 500

3000 K STREET NW

WASHINGTON, DC 20007

EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

03/30/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,436

Applicant(s)

MOUSSY ET AL.

Examiner

Laura L. Stockton, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 15 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-942)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

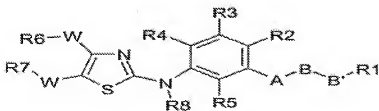
Claims 1-12 and 15 are pending in the application.

Election/Restrictions

Applicant's election with traverse of modified Group I (claims 1-12) in the reply filed on April 12, 2010 was acknowledged in the previous Office Action.

Modified Group I, as agreed upon in the telephonic interview of April 6, 2010 is as follows:

Group I. Claims 1-12 (in-part), drawn to products of formula I of claim 1



FORMULA I

wherein **A-B-B'** is CO-NH, CO-NCH₃ or CO-NR^{*}; **R**¹ is aryl; each **W** is a bond; and one of **R**⁶ and **R**⁷ is heteroaryl.

The requirement was deemed proper and therefore made FINAL in the previous Office Action.

Claim 15 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 12, 2010.

Rejections made in the previous Office Action that do not appear below have been overcome by Applicant's amendments to the claims. Therefore, arguments pertaining to these rejections will not be addressed.

Claim Objections

Claim 6 is objected to because of the following informalities: claim 6 fails to end with a period. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 3, 4 and 7, it is unclear what is meant by the expressions "a pendant basic nitrogen functionality" and "a basic nitrogen functionality", which is found in several variable definitions, such as the R⁶ and R⁷ variables. A term is not indefinite if the

determination of its meaning "is not beyond skill of the art and does not involve undue experimentation" In re Halleck, 164 USPQ 647. The expression does not meet that standard because it will involve undue experimentation. Further, if there are several different ways of calculating a parameter, and the specification fails to indicate which method is to be employed, then the claims are indefinite, Harrah's Entertainment Inc. v. Station Casinos Inc., 71 USPQ2d 1439 (DC Nev 2004). In the instant case, the question is how is the basic nitrogen functionality determined? Is the "basic nitrogen functionality" a Lewis base or a Brønsted base? The instant specification fails to give a clear and concise definition of the expression "basic nitrogen functionality". Is the nitrogen directly attached or indirectly attached? Additionally, the claims metes and bounds cannot be ascertained since there is no structural information, other than having a nitrogen, associated with the expressions "a pendant

basic nitrogen functionality" and "basic nitrogen functionality". Therefore, the expression "basic nitrogen functionality" and "a pendant basic nitrogen functionality" are indefinite.

In claim 4, variable X lacks antecedent basis from claim 1.

In claims 4 and 6, "formula II" lacks antecedent basis from claim 1.

Response to Arguments

Applicant's arguments filed January 14, 2011 have been fully considered but they are not persuasive. Applicant argues that: (1) the recitation "a pendant basic nitrogen functionality" is not indefinite because its plain meaning can be ascertained by those of ordinary skill in the art; (2) a number of U.S. patents have this language; and (3) instant claim 4 gives examples of a pendant basic nitrogen functionality.

All of Applicant's arguments but have not been found persuasive. Firstly, see above statements concerning why the expression "basic nitrogen functionality" is found indefinite. Further, the instant specification fails to completely define the expression "basic nitrogen functionality" nor give a complete structural depiction of all the substituents, or radicals, embraced by the expression "basic nitrogen functionality". On page 17 of the instant specification, examples of X substituents substituted with a "basic nitrogen functionality" is shown in structures a to f. But again, the instant specification fails to completely define the expression "basic nitrogen functionality". Applicant then turns to U.S. patents in order to establish a definition of the phrases "a pendant basic nitrogen functionality" and "a basic nitrogen functionality". However, the instant specification has failed to define the above noted phrases. It is noted that Applicant did not present

any textbook references to establish that the phrases "a pendant basic nitrogen functionality" and "a basic nitrogen functionality" are art recognized terminology. For all the reasons given above, the rejection is deemed proper and therefore, the rejection is maintained.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

This application contains claim 15 drawn to an invention nonelected with traverse in the reply filed on April 12, 2010. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the

examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

/Laura L. Stockton/
Laura L. Stockton, Ph.D.
Primary Examiner, Art Unit 1626
Work Group 1620
Technology Center 1600

March 28, 2011